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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,250	06/20/2003	Hamid G. Kia	H-205868	6691

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General Motors Corporation - Legal Staff  
Kathryn A. Marra  
Mail Code 482-C23-B21  
P.O. Box 300  
Detroit, MI 48265-3000

EXAMINER

DIXON, MERRICK L

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/601,250	KIA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Merrick Dixon	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**MERRICK DIXON**  
**PRIMARY EXAMINER**

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2

Claims 1-7,10,35 and 37 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11,15,20,30-34,37 and 45 are of copending Application No. 10/601269. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 16-19,22-24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by GB Patent (1493547).

The cited reference teaches the claimed composite article comprising laminate layer of specific weight percent fibers , polyester resin material of specific weight amounts, filler material of specific amounts and an initiator material; a gel coat layer and a barrier layer – page 4, col 2, lines 75-125; page 1, col 1, lines 29-32; page 1, col 2, lines 73-88;; page 2, col 2, lines 90-117; page 3, col 1, lines 34-48; page 3, lines 71-83. concerning claim 17, the reference teaches automobile product in page 5, col 2, lines 90-96. concerning claim 18, the reference teaches similar article thickness in page 4, lines 105-106. concerning claim 19, the reference teaches similar article dimensions, and gel,barrier coat and laminate thickness on page 4, lines 105-126. concerning claims 23-24, the reference teaches similar claimed fiber lengths in page 4, line 76; page 3, col 2, lines 75-80. concerning claim 26, the reference teaches similar laminate density in page 4, col 2, lines 107-108.

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Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Okayama (JP2001-150559).

The cited reference teaches the claimed process including applying a gel coat into a mold, applying a barrier layer thereover, and applying a laminate over the barrier layer- Abstract. It is noted those limitations relating to the process are submitted to be germane to the instant question for patentability, not those relating “article- specifics”.

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Such article-specific limitations amount to "structural limitations". See *Ex parte Pfeiffer*, 1962 C.D. 408(1961). . Accordingly, applicants' limitations directed to weights of the recited material and fillers, are of no patentable consequences to the instant question for patentability which must be manipulatively distinct. Thus and relating to claims 2-8, the types and amounts of material used during claimed process are of no patentable consequences which must be manipulatively distinct for reasons as stated above.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 10 , 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okayama (JP2001-150559) in view of GB Patent (1493547). The primary reference to JP-2001-150559 teaches the claimed process but fails to teach using spray gun means to apply coating to the substrate to desired thickness. The secondary reference, however, teaches that it is known in the art to employ gun spraying means to impart desired thickness to fiber reinforced laminate product as taught by the primary reference- page 3, col 2, lines 100-104. It would have been obvious to one of ordinary skill in the art at the time the invention is made to combine the teachings of the

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secondary reference and utilize such employment in the GB Patent with the motivation to obtain desired/controlled coating dimensions- page 5, lines 16-22. the primary reference teaches the claimed polyester resin as required by claim 25.

8

Claims 10-15,20 , 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB Patent (1493547) in view of Maker(US 5087405).

The cited primary UK patent teaches the claimed invention including a laminate composition including an unsaturated polyester resin, initiator material and filler of specific dimensions- page 1, lines 30-36; page 3, lines 72-83. The primary reference fails to teach the inclusion of marble-like microspheres in its composition. The secondary reference to Maker, however, teaches that it is known in the instant art to include such marble microsphere particles in fiber reinforced laminate such as taught by the primary reference- col 11, lines 1-15. It would have been obvious to one of ordinary skill in the art at the time the invention is made to combine the teachings of the secondary reference to Maker and provide the primary reference with such marble-like particles to enhance the respective layers' adhesion- col 11, lines 46-49. It is noted that the phrase, "capable of" in line 5 of claim 10, is not a positive limitation and does not constitute a limitation in any patentable sense what so ever- In re Hutchinson, 69 USPQ 138. However, it is submitted that the recited initiator of the primary reference would possess such claimed characteristics/abilities, in the absence of unexpected results. Concerning claim 14, the secondary reference teaches calcium carbonate coating in col

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11, line 10-49. concerning claims 11, 37, and 12, the primary reference teaches fibers of similar material, weight and lengths-page 3, lines 72-83; page 4, lines 70-79.

Concerning claims 13,20, and 27-29 the secondary reference teaches polymeric marble microspheres of specific compositions, Example 11. The secondary reference does not exclude such microspheres be hollow and accordingly , it is submitted it would have been obvious to utilize same in the absence of unexpected results. It is further submitted that discovering the optimum or workable ranges where the general conditions of a claim are disclosed in the prior art, involves only routine skill in the art. In re Aller, 105 USPQ 233. Thus, the claimed marble microspheres compositions would have been obvious, in the absence of unexpected results. Concerning claim 15, the primary reference teaches similar densities in page 4, lines 95-105. Concerning claims 38-39, the UK patent teaches similar claimed article thickness in page 4, lines 75-79.

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Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent (JP-2001-150559) and GB Patent(1493547) as applied to claims 10 and 25 above, and further in view of Maker(US 5087405). Maker teaches that it is known in the art utilize thermoset resin in fiber reinforced laminate as taught by the above obvious combined teaching of the references as set forth above- col 3, lines 6-13. It would have been obvious to one having ordinary skill in the art at the time the invention is made to substitute thermosetting resin in the submitted teachings , since it has long being held to be within the general skill of a worker in the art to select a known material on the basis

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of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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Claims 30-32, 34 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Okayama (JP2001-150559) in view of Marker (US 5087405).

The primary reference teaches the claimed process as discussed above, inter alia. The primary reference, however, fails to teach the aspect of hand lay a layer material onto its laminated fiber reinforced product. The secondary reference to Marker, however, teaches that it is known in the art to apply layer material via hand application (brush laying) – col 2, lines 64-65; col 3, lines 3-14. it would have been obvious to one of ordinary skill in the art at the time the invention is made to hand-lay desired layers to laminated fiber reinforced products as taught by the primary reference in the absence of unexpected results motivated by the desire to impart desired and manipulated product properties. Both references are combineable for they teach fiber reinforced laminated articles. Concerning claims 31-32, the secondary reference expressly teaches curing its product – col 2, lines 65-66. concerning claim 34, the primary reference teaches weight amounts for its polyester resin in page 2, lines 94-100. it stands to reason the remaining weight percentage for the marble spheres of the secondary reference would naturally amount to the weight amount claimed (for a 100% composition amount).

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Claims 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maker(US 5087405) and GB Patent(1493547) as applied to claims 30-32 and 34 above, and further in view of Okayama(JP2001-150559). The Okayama reference teaches that it is known in the art to employ dicyclopentadiene polyester resin in fiber reinforced product as taught by the cited references- Abstract. It would have been obvious to one of ordinary skill in the art at the time the invention is made to combine the teachings of Okayama and select known and specific polyester material, as taught by Okayama, in the obvious combined teachings of the references as set forth above motivated by the desire to impart desired characteristics to the respective product. Such selection is believed a mere matter of obvious design choice. In re Leshin 125 USPQ 416.

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Applicant's arguments filed 10-5-05 have been fully considered but they are not persuasive. Applicants argued that the instant claimed invention and the 10/601269 application are not the same because they refer to different inventions as shown by the respective preambles. The examiner respectively disagrees. Both inventions recite identical process limitations and thus are the same. Applicants further argue that the GB patent does not teach barrier layers or gel coats. The examiner disagrees on page 4, lines 105-126, the reference discloses gel and barrier layers of specific thickness. Applicants further argue that the okayama reference does not anticipate the claimed process and In re Pfeiffer is not applicable to the current case. The examiner disagrees. Applicants are claiming process limitations and accordingly, such limitations are

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germane to the instant question for patentability. To be entitled to patentability, any disclosed/claimed limitations directed to article limitations, must affect the process in a manipulative sense. Applicants argue the obvious rejection of claims 9 and 25 Submitting that such combination, as offered by the examiner, would not lead to the subject matter of claims 9 and 25. the examiner disagrees and reiterate that the combined references' teachings as offered, does indeed teach the invention as claimed. The examiner respectfully remind applicants that the references, as combined and offered by the examiner, is done for reasons as articulated in the office action and that those as reasoned by applicants. Accordingly, applicants cannot show how the obvious combined references fail to teach the claimed invention by attacking the references singularly. Applicants further argue the obvious combined teachings of the cited references against claims 10-15,20,27-29 and 37, submitting that the Marker reference uses calcium carbonate and not hollow microspheres as required by the instant claimed invention. The examiner disagrees The Marker reference teaches microspheres in col 11, lines 1-15. It is submitted such microspheres would also includes hollow types for the reference does not expressly exclude such types. Applicants argue that claim 9 is a process claim. It appears the claims are misnumbered and the claim referred to is 10.( after claim 8, that is). Applicants finally argued that the references fail to teach a hand laying process comprising placind/coating a layer on a receptor layer. The examiner disagrees and direct applicants to Marker, col 2, lines 64-65; col 3, lines 3-14.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 ( November 15, 1989). **NOTE: All facsimiles sent to the examiner's personal fax number should be in draft-forms and will be treated as informal.**

**Same facsimiles will not be entered** in the related applications unless otherwise agreed and noted by the examiner.

**The fax number for all other fascimile is 571-273-8300.**

Information about **the status of an application** may be obtained from the Patent Information Retrieval system (**Private PAIR**).

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Status inquires for **published applications** may be retrieved from either **Private PAIR** or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic Business Center at **866-217-9197**.

Any questions concerning the instant communication should be directed to Examiner Dixon, at 571-272-1520, Mondays, Wednesdays and Thursdays, between 12 noon and 8 PM, eastern time .

A handwritten signature in black ink, appearing to read 'Merrick Dixon', with a stylized, flowing script.

Merrick Dixon

Primary Examiner

Group 1700